

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed 01/16/2004. Reconsideration and allowance of the application and presently pending claims as amended, are respectfully requested.

1. **Present Status of Patent Application**

Upon entry of the amendments in this response, the following amended and new claims will be pending:

Original claims: 2 -20

New claims: none

Claims 1 is cancelled. The amendments and additional new claims are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

2. **Response to Rejections of Claims 13 & 14 under 35 U.S.C. §112**

In the Office Action, claims 13 and 14 stand rejected under 35 U.S.C. §112, first paragraph, as failing to compile with the enablement requirements in that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected, to make and/or use the invention.

The office action asserts that the device as claimed, being an audio control device or video control device, was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The office action goes on to assert that applicant has merely stated that the device may be an audio control device or video control device, but no disclosure is made as to how these devices would actually be configured so as to be usable with the yoke as disclosed.

Applicants respectfully disagree with the assertions of the Office action and would note that audio control devices and video control devices are in fact very well known, particularly by those skilled in the art. These devices are generally electrical /electro-optical devices. These devices are used to control the distribution and/or character of audio signals and video signals. More particularly, they are used to distribute and control the character of one or more audio/video signal(s). These devices include switches for controlling the distribution of the electrical current of an audio signal to another device, such as an audio-transducer(speaker) or audio device (amplifier, audio processor), as well as devices for controlling the characteristics of the audio signal, for example, amplitude (volume) and/or frequency (tone) characteristics. These devices also include switches for controlling the distribution of the electrical current of a video signal to another device, such as a video processor or display device, as well as devices for controlling the characteristics of the video signal, for example, brightness, contrast characteristics.

For those skilled in the art, it will be recognized that audio control devices include any and all devices capable of controlling the distribution or character of an audio signal (i.e. an electrical signal representative of an audible sound). Similarly, it will be recognized by those skilled in the art that video control devices include any and all devices capable of controlling the distribution or character of a video signal (i.e. and electrical signal representative of a still image or moving image). Further, those skilled in the art will clearly recognize that such audio control devices and video control devices may be configured to include a yoke as described and claimed herein. The present invention includes all electrical devices that incorporate a yoke/mounting system as described and claimed herein.

In view of the above, Applicant believes that claims 13 and 14 as originally submitted meet all requirements of 35 U.S.C. §112 and are thus allowable. Reconsideration of the rejection of claims 13 and 14 is respectfully requested.

3. Response to Rejection of Claims 1,2,3,6,9,10,11,15,16 and 19 under 35 U.S.C. §102

Claims 1,2,3,6,9,10,11,15,16 and 19 stand rejected under 35 U.S.C. §102 (b) as being anticipated by GLADER (USP 3689864). Applicants respectfully disagree with the assertions of the office action herein, and submit that claims 1,2,3,6,9,10,11,15,16 and 19 are not anticipated by GLADER. In order for a claim to be anticipated by the prior art, each and every limitation specified by the claim at issue must be found in the prior art. Applicants submit that the cited art fails to disclose each and every limitation specified by the claims herein as originally submitted.

RE: CLAIM 1 - With respect to claim 1, the office action asserts that GLADER discloses an electrical device comprising a mounting yoke 13a for mounting said electrical device into an outlet box. Claim 1 has now been cancelled from the application.

RE: CLAIM 2 - With respect to claim 2, the office action asserts that GLADER discloses a yoke that comprises "*a slotted mounting hole (that portion of the slot where the bolt B is located) for receiving a mounting screw B, and a channel leading into said slotted mounting hole (see figure 1, the portion of the hole visible on both sides of the bolt B)*".

Applicants submit that the diagrams of GLADER do not clearly show anything more than the head 20 of bolt B and *the portion of the hole visible on both sides of the bolt B*. Thus, it is unclear, at best, what the nature of any hole/slot obstructed from view by the head 20 of bolt B might be. In fact on first review of GLADER, Applicant had to wonder how it is that GLADER allows bolt B to ever enter any portion of what appears to be a slot that includes both "those portions visible on both sides of the bolt B", so that the advantages of the invention can ever be achieved. From a review of the specification (column 2, lines 11-19), it is noted that the bolt B includes a head 20 and a collar 24 each of which are fixed to the shank 22.

If the obstructed hole/slot is in fact a slot like opening large enough to receive the diameter of head 20 (or collar 24) of the bolt B, one has to ask how it is that the yoke 13a could be securely held in place between the head 20 and collar 24 of bolt B, as GLADER is attempting to accomplish. Such an opening

would allow the yoke 13a to freely move "over" the head 20 (or below the collar 24) of bolt B to an unsecure position. In order to secure the yoke between head 20 and collar 24, it appears the yoke 13a would have to be moved to either side of the hole/slot in order to enter into one of *"those portions of the hole visible on both sides of the bolt B"*, each of which appear to be narrower than the diameter of head 20 or the collar 24. In this position, the receptacle 13 would be off center with the bolts B or otherwise diagonally/mis-aligned in relation to the outlet box or any face plate that might be installed over the receptacle 13.

On the other hand, if the obstructed hole/slot is in fact a slot like opening, too narrow to receive the diameter of head 20 (or collar 24) of the bolt B, one has to ask how it is that the bolt B could ever be inserted into the slot/hole and thus, ever receive the yoke 13a between head 20 and collar 24.

In view of the above, it is respectfully submitted that GLADER fails to show the invention of claim 2, as originally submitted, and thus does not anticipate claim 2. Nonetheless, claim 2 has been amended herein, as discussed below, to further clarify the invention. Reconsideration and allowance of claim 2 is respectfully requested.

RE: CLAIM 3 - With respect to claim 3, the office action asserts that GLADER discloses a mounting screw that comprises an elongated post, a head 20 positioned at one end of the elongated post and a support rim 24 positioned along the elongated post at a predetermined distance from said head and in a plane that is substantially parallel to the plane in which said head lies.

In order for a dependent claim to be anticipated by the prior art, the prior art must show each and every limitation specified by the claim. In the case of a dependent claim, this means each and every limitation of the independent claims and any intervening claims, must also be found in the prior art. Applicant would repeat here the same arguments and remarks set out above concerning original claim 2. In view of this, it is believed that pending claim 3 is not anticipated by the prior art and otherwise meets all requirements for patentability. Reconsideration and allowance of claim 3 is requested.

RE: CLAIM 6 - With respect to claim 6, the office action asserts that GLADER discloses a channel that comprises a substantially enclosed opening. Applicants respectfully note that the details of the hole/slot obstructed from view in the various Figures shown in GLADER are, at best, not clear as discussed above with respect to claim 2. There is simply no indication of a channel that comprises a substantially enclosed opening. In view of this, and for the same reasons set out with respect to claim 2, Applicant submits that claim 6 as originally submitted is not anticipated by GLADER. Reconsideration and allowance is requested.

RE: CLAIM 9 - With respect to claim 9, the office action asserts that GLADER discloses a channel that is generally circular in shape. Applicants respectfully note that the details of the hole/slot obstructed from view in the various Figures shown in GLADER are, at best, not clear as discussed above with respect to claim 2. There is simply no indication of a channel that is generally circular in shape. In view of this, and for the same reasons set out with respect to claim 2, Applicant submits that claim 9 as originally submitted is not anticipated by GLADER. Reconsideration and allowance is requested.

RE: CLAIM 10 - With respect to claim 10, the office action asserts that GLADER discloses a channel that is configured so as to be large enough to accommodate the head of the mounting screw. Applicants respectfully note that the details of the hole/slot obstructed from view in the various Figures shown in GLADER are, at best, not clear as discussed above with respect to claim 2. There is simply no indication of a channel that will accommodate the head of mounting screw. In view of this, and for the same reasons set out with respect to claim 2, Applicant submits that claim 10 as originally submitted is not anticipated by GLADER. Reconsideration and allowance is requested.

RE: CLAIM 11 - With respect to claim 11, the office action asserts that GLADER discloses a receptacle. Claim 11 is dependent upon claim 2. A dependent claim is allowable where the independent claim from which it depends is allowable. In view of the above, remarks concerning claim 2, it is believed that independent claim 2 as originally submitted is allowable. Similarly, it is submitted

that dependent claim 11 is also allow for at least the same reasons set out above with respect to claim 2. Reconsideration and allowance is requested.

RE: CLAIMS 15, 16, and 19 – Claims 15, 16 and 19 have been rejected for the same reason put forth with respect to the rejection of claims 1,2,3,6,9, 10 and 11. In response, Applicant would submit that these claims are in fact allow over GLADER for at least the same reason set out above with respect to the rejection of claim 2. Reconsideration and allowance is requested.

4. Response to Rejection of Claims 1,2,3 and 12 under 35 U.S.C. §102

Claims 1,2,3 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by SLATER (USP 3403215). With respect to claims 1, 2 and 3, the office action simply states that “SLATER discloses the device as claimed (see figures 1-4)”.

Applicants respectfully disagree with the assertions of the office action herein, and submit that original claims 1,2,3 and 12 are not anticipated by SLATER. In order for a claim to be anticipated by the prior art, each and every limitation specified by the claim at issue must be found in the prior art. Applicants submit that the cited art fails to disclose each and every limitation specified by the claims herein as originally submitted.

RE: Claim 1 – Claim 1 has been cancelled herein.

RE: Claim 2, Claim 3 & Claim 12 – Applicant notes that SLATER fails to disclose or otherwise suggest a slotted mounting hole for receiving a mounting screw; and a channel leading into the mounting hole, as specified and required by claim 2 as originally submitted.

With reference to figures 1-4, it can be seen that SLATER shows a rearward offset 16, aperture 17, slit 24, slot 23 and U-shaped opening 25. The specification states that “the portion between the arms of the U 26 being bent outwardly to form a camming surface, and the area above the upper edge of that camming surface forming essentially a horizontal extending slot which, as will be seen, permits of adjustment of the position of the mounting strap and hence of the airing device relative to the outlet box 10...”(column 3, lines 13 – 25). A

mounting screw 27 is inserted through the opening 25 (column 3, lines 26-32). Nowhere is there a disclosure found in SLATER of a slotted mounting hole for receiving a mounting screw; and a channel leading into the mounting hole, as specified and required by claim 2. In view of this, it is submitted that SLATER fails to anticipate claim 2 as originally submitted. For this same reason, it is submitted that claim 3 and claim 12, both of which depend from claim 2, are also not anticipated by SLATER.

Nonetheless, Claim 2 has been amended herein to further clarify the features and attributes of the claimed invention. More particularly, claim 2 has been amended to specify and require, among other things, *"a channel leading into said slotted mounting hole through which said mounting screw is inserted into said mounting hole"*.

5. Response to Rejection of Claim 17 under 35 U.S.C. §102

Claims 1,2,3 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by EDER (USP 5389011). The office action states that EDER "discloses an electrical device comprising a mounting yoke for mounting said electrical yoke into an outlet box; said mounting yoke comprises: slotted mounting hole 21 (see figure 2) for (i.e. capable of receiving) receiving a mounting screw; and score line 22 delineating a portion of the yoke that can be removed to form a channel that opens into said slotted mounting hole (where the portion of the slot remaining on the extension 16, 18, is capable of being used as the mounting hole)."

6. Rejection of claims 4, 5, 7 and 8 under 35 U.S.C. §103

Claims 4, 5, 7 and 8 have been rejected as being unpatentable over GLADER in view of HUBBELL et al (USP 2966654).

It is respectfully submitted that the Office Action herein has failed to establish a case of prima facie obviousness with regard to claims 4, 5, 7 and 8. The mere fact that the prior art can be modified so as to result in the combination defined by the claims at issue does not make the modification obvious unless the

prior art suggests the desirability of such modification. Further, each and every limitation of the claim at issue must be considered. In the case of dependent claims, such as claims 4, 5, 7 and 8, this requires that each and every limitation of the independent claim (claim 1) and any intervening claims, from which they depend also be considered.

It is completely improper to use the present claimed invention as a guide through the maze of prior art references in order to combine references in just the right way so as to achieve the results of the claims at issue. In short, the references cited by the Office Action herein do not suggest or otherwise teach the desirability of the present claimed invention. The present invention has been used as a road map for attempting to modify GLADER and HUBBELL to achieve a device that arguably would include attributes of the present claimed invention.

With respect to claims 4 and 5, the office action asserts that the "Glader slot does not extend from the outer edge. Hubbell discloses a yoke where the slot 43 extends from an outer edge to the mounting hole (where the mounting hole is the portion of the slot occupied by the screw when the yoke is attached to the box 2)" and , further that "it would have been obvious to configure the Glade[sic] slot as a slot opened to the outer edge of the yoke as taught in Hubbell".

As discussed above with respect to the rejection of claim 2 under 35 U.S.C. §102 as being anticipated by GLADER, it is at best unclear just what the nature of the slot/hole hidden from view by bolt B in the views of GLADER might actually be and how it is that the bolt B might actually be inserted into such slot/hole.

Further, GLADER is directed to an extension connector for an electrical outlet box for providing a threaded connector bolt having a head element and collar element fixed thereto and respectively positioned on opposite sides of the attachment ear of an electrical unit with a spring member interposed between one of the elements and the ear to maintain positive electrical contact between the ear and the connector bolt (column 1, lines 28 – 34).

Hubbell is directed to a wire bridge for mounting electrical wiring devices. The bridge is made from a piece of round wire swaged to a flat or oval shaped cross section at its opposite ends (column 2, lines 14 – 17. The flattened end portions 38 comprise substantially U-shaped outer end portions 42 with a slot or recess 43 opening through one side, and a shorter but oppositely facing substantially U-shaped portion 44 connecting the inner leg of this outer U-shaped portion with the end of the intermediate portion 41. The outer end forms a hook opening laterally at each end of the bridge, which may be hooked over the shanks of the mounting screws 3 in the lugs 4 of the wall box to thus mount the receptacle in the outlet box. (column 2, lines 23 – 34). Hubbell does not show a channel or otherwise suggest a channel which extends from an outer edge of the yoke into the slotted hole, as specified and required by original claim 4 and dependent claim 7, or a channel positioned so as to open into a slotted mounting hole as required by original claim 5 and dependent claim 8.

Applicant submits that any attempt to “modify” the features of GLADER to incorporate the features of Hubbell would result in destruction of the yoke described in GLADER. Bending the yoke of GLADER to form the “hooks” of HUBBELL would simply result in the yoke being destroyed. The such modification will not work. Alternatively, any suggestion that HUBBELL should be modified to incorporate the channel in the “yoke” of HUBBELL (wire bridge 37) that extends from the outer edge of the yoke /wire bridge 37 as required by the claims, is not connected with any clear indication of how such a modification/combination would actually be implemented without either destroying the device of HUBBELL and/or GLADER or would actually meet the requirements specified by the claims herein. In view of the above, it is respectfully submitted that the proposed combination of GLADER and HUBBELL is not only not obvious, but not possible. Reconsideration and allowance of original claims 4, 5, 7 and 8 is requested.

7. Rejection of claims 13-14 and 20 under 35 U.S.C. §103

Claims 13-14 and 20 have been rejected as being unpatentable over GLADER in view of SLATER et al (USPxxx). The office action acknowledges that while GLADER and SLATER show a receptacle and a switch, they do not show other devices such as audio or video controls. The office action asserts that it would have been obvious to substitute various devices for the receptacle or switch.

It is respectfully submitted that the Office Action herein has failed to establish a case of prima facie obviousness with regard to claims 13-14 and 20. The mere fact that the prior art can be modified so as to result in the combination defined by the claims at issue does not make the modification obvious unless the prior art suggests the desirability of such modification. Further, each and every limitation of the claim at issue must be considered. In the case of dependent claims, such as claims 13-14 and 20, this requires that each and every limitation of the independent claim (claim 1 and 19) and any intervening claims, from which they depend also be considered.

It is completely improper to use the present claimed invention as a guide through the maze of prior art references in order to combine references in just the right way so as to achieve the results of the claims at issue. In short, the references cited by the Office Action herein do not suggest or otherwise teach the desirability of the present claimed invention.

Applicants would respectfully repeat the arguments made above with respect to original claims 1, 2, 15 and 19. As it is submitted that the prior art fails to show or otherwise suggest each and every element specified by these claims, it is further asserted that the claims depending there from are also not shown or otherwise suggested. Reconsideration and allowance of original claims 13-14 and 20 is respectfully requested.

8. Rejection of claim 18 under 35 U.S.C. §103(a)

Claim 18 has been rejected as being unpatentable over EDER in view of SLATER. The office action asserts that Eder discloses a receptacle and

that Slater shows a switch and that it would have been obvious to substitute various devices for the receptacle, such as a switch as taught in Slater.

It is respectfully submitted that the Office Action herein has failed to establish a case of prima facie obviousness with regard to claim 18. The mere fact that the prior art can be modified so as to result in the combination defined by the claims at issue does not make the modification obvious unless the prior art suggests the desirability of such modification. Further, each and every limitation of the claim at issue must be considered. In the case of dependent claims, such as claim 18, this requires that each and every limitation of the independent claim (claim 15) and any intervening claims, from which they depend also be considered.

Applicants would respectfully repeat the arguments made above with respect to original claims 1, 2, 13, 14, 15, 19 and 20. As it is submitted that the prior art fails to show or otherwise suggest each and every element specified by these claims, it is further asserted that the claims depending there from are also not shown or otherwise suggested. Reconsideration and allowance of original claim 18 is respectfully requested.

9. Amended Claims

Claim 2 has been rewritten in independent format and now incorporates the limitations of original claim 1. Further claim 2 has been amended to specify ; among other things, *a channel leading into said slotted mounting hole through which said mounting screw is inserted into said mounting hole.* This claim as well as all original dependent claims 3 – 14 are believed to meet all requirements for allowance.

Claim 15 has been amended to specify, among other things, *a channel configured to open into said slotted mounting hole for inserting said mounting screw into said slotted mounting hole.* This claim as well as all original dependent claim 16 are believed to meet all requirements for allowance.


Claim 17 has been amended to specify, among other things, *a channel configured to open into said slotted mounting hole for inserting said mounting*

screw into said slotted mounting hole. This claim as well as original dependent claim 18 are believed to meet all requirements for allowance.

Claim 19 has been amended to specify, among other things, *a channel configured to open into said slotted mounting hole for inserting said mounting screw into said slotted mounting hole.* This claim as well as original dependent claim 20 are believed to meet all requirements for allowance.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 2 - 20 are in condition for allowance. Favorable re-consideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (678) 352-0103.

<p align="center">Certificate of Mailing</p> <p>I hereby certify that this correspondence, and attachments, if any, is being deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.</p> <p>DATE: November 10, 2004</p> <p> Robert P. Biddle (Reg# 35, 826) 6300 Powers Ferry Road Suite 600-183 Atlanta, GA 30339</p> <p>TEL: 678-352-0103 FAX: 404-795-0870</p>

Respectfully submitted,

BIDDLE & ASSOCIATES, P.C.

By: 

Robert P. Biddle

(Reg # 35, 826)



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On: 10 November 2004

Robert P. Biddle

In re
PATENT
application of: Elmer Algin Rose
Serial No: 10/700,822
Filed: 4 November 2003
Title: ELECTRICAL DEVICE WITH MOUNTING SYSTEM
Examiner: GUSHI, ROSS N.
Group No.: 2833
Docket No.: 88030096

Attached are the following documents for filing with the USPTO:

- ☒ - Return Postcard
- ☒ - Amendment Transmittal Form (1 Page(s))
- ☒ - Petition for Extension of Time - 1st Month (1 page(s))
- ☒ - Amendment & Response to Office Action (16 pages(s))
- ☐ - PTO SB0038 (CC Payment Form \$)
- X BA Check # 1893 - \$55.00